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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/549,658	09/16/2005	Paul Raymond Smith	739-71455-01	7658

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EXAMINER	
HANNON, THOMAS R	

ART UNIT	PAPER NUMBER
3682	

MAIL DATE	DELIVERY MODE
03/25/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/549,658	SMITH ET AL.	
	Examiner	Art Unit	
	Thomas R. Hannon	3682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 February 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7 and 9-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7 and 9-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20 February 2008* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

The drawings were received on February 20, 2008. These drawings are approved.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 17 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no description in the original disclosure for claiming "the rigid inner race and the elastomeric portion have respective inner surfaces that substantially conform to the shape of the ball." While the rigid inner race (including the liner) conforms to the outer surface of the ball, the elastomeric portion, being spaced radially outward from the ball surface cannot conform to the shape of the ball.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-7, 15, 16, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Saitamakiki GB 1,360,515. First, it is noted the patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Saitamikiki discloses a bearing arrangement comprising a spherical bearing having a bearing housing (7, 8, 9, 10) and a ball (6) located therein, the bearing housing having a rigid outer race (10) and a rigid inner race (9, or 9 and 7) and an elastomeric portion (8) sandwiched between the races. The outer race 10 is securely held in an interference fit (press fit, column 2, line 61) hole in torque rod 11. The "predetermined range" of torque of claim 1 is inherently "non-zero" and is anticipated by the arrangement of Saitamakiki. With respect to claim 4, the elastomeric portion 8 is bonded to the inner and outer races (col. 2, lines 53-56). With respect to claims 5, 6, and 15, the blocks 7 are liners provided on inner race 9 and in contact with the ball 6; the blocks 7 formed of Delrin, which is a self-lubricating material. With respect to claims 7 and 16, column 2, lines 33-34 disclose the blocks may be formed of "sintered alloy" which is a metal in contact with the metal ball 6.

Claims 2, 3, and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saitamakiki GB 1,360,515.

With respect to claims 2 and 3, the specific ranges of the oscillatory torque would have been obvious to one of ordinary skill in the art, as such ranges are subject to optimization based on specific or desired uses of the device. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

Applicant's arguments filed February 20, 2008 have been fully considered but they are not persuasive. Applicant argues the "the disclosure of Saitamakiki makes it clear that there is zero torque between the ball and the housing." Applicant supports this allegation by stating "As one of ordinary skill in the art appreciates, for a torque to exist between two structures, there

must be contact between those structures; i.e. there can be no gap or space between two structures. In the ball joint of Saitamakiki, lubricating material 20 is placed between the ball 6 and the bearing housing 9…Thus, some small gap must exist between the ball 6 and bearing housing 9 or between the ball 6 and the bearing block 7 prior to being installed in an interference fit hole." Applicant's allegations are unsupported by any evidence. Additionally, it is disputed that "for a torque to exist between two structures, there must be contact between those structures". A torque may exist between two structures through an additional element. The fact that Saitamakiki discloses lubricating material between two parts does not preclude the two parts from contacting. The purpose of such a lubrication material would be to reduce the friction between the two parts caused by contact between the two parts. Applicant's additional argument that Saitamakiki "suggests that the ball 6 will not be tight-fitting in the ball joint because a check ring 12 is required to retain the components in the housing" is further not persuasive. The description in Saitamakiki with respect to the check ring does nothing to suggest anything other than that it retains the bearing block in the housing. A non-zero torque is deemed to be an inherent feature in the device of Saitamakiki. Based on the similarity of structure, the functional limitation of non-zero torque is an inherent characteristic of Saitamiakiki. In accordance with *In re Best*, 562 F.2d 11252, 195 USPQ 430, 433 (CCPA 1977):

> [W]here the Patent Office has reason to believe that a functional limitation assrerted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

This "burden of rebutting [may be of] the PTO's reasonable assertion of inherency under 35 USC 102, or of prima facie obviousness under 35 USC 103" (195 USPQ at 432).

Accordingly, the burden is placed upon the applicant to prove that the non-zero torque limitation in question is not an inherent characteristic of Saitamakiki.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas R. Hannon whose telephone number is (571) 272-7104. The examiner can normally be reached on Monday-Thursday (8:30-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on (571) 272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thomas R. Hannon/
Primary Examiner, Art Unit 3682